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10/656,476	09/05/2003	Carey E. Garibay	BEAS-01454US5	8634

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EXAMINER	
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ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/656,476	GARIBAY ET AL.	
	Examiner	Art Unit	
	Charlie C. Agwumezie	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33 and 37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33 and 37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *01/8/04; 03/11/05*. 8/14/07
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgment

1. Applicants argument filed on August 14, 2007 is acknowledged. Accordingly claims 1-33 and 37 remain pending.

Response to Arguments

2. Applicant's arguments filed August 14, 2007 have been fully considered but they are not persuasive.

With respect to **claims 1, 12 and 23**, Applicant argues that Stupek does not suggest that the later downgrade involve obtaining a second license key. Specifically, that viewing all the references together would not suggest a downgrade system that obtains a second license key.

In response, Examiner respectfully disagrees and submits that Stupek's disclosure do suggest a downgrade system that obtains a second key. For example when installing software, a license key is usually required. When downgrading the software to a lower version, it would be obvious that the software key of the lower version should be used rather than the existing key for the later version. Thus the key for the later version that is being downgraded must automatically be disabled or cease to exist. Another way to look at this is for example you install software version 1.0 with license key 1. You later upgrade the license to version 1.1 with license key 2. Automatically the license key 1 is disabled allowing the new key 2 to function. Assuming you decide to downgrade the software to version 1.0 again the license key 2 will be

disabled and allowing the license key 1 to function again. Thus Stupek does disclose the claimed limitation.

With respect to dependent claims, Applicant argues are allowable being dependent on claims 1, 12, and 23.

In response, Examiner disagrees and submits that these claims are not allowable over the references of records.

With respect to **claim 37**, Applicant argues that Watanabe does not disclose a software license bank for a customer that stores a predetermined dollar amount of licenses. Applicant however stated that Watanabe does disclose a software bank for sublicensee rather than a customer.

In response, Examiner disagrees with Applicant's characterization and submits that a sublicensee could be a customer or user.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 5, 7-10,12-13,16,18, 19-21, 23-24, 27, 29-31, and 32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication 2004/0039916 A1 in view of Stupek Jr. et al Patent No. 5,960,187.

As per **claim 1, 12 and 23**, Aldis et al discloses a method comprising:

maintaining a software license bank for a customer, software licenses stored in the software license bank not being associated with specific machines (fig.1 and 11; 0013, 0014, 0018, claim 61); and

accessing a web application to allow a user to automatically obtain a software license for a specific machine from the software license bank, wherein the software license is associated with a first license key (figs.1, 6 and 7; 0014, 0016, 0017, 0018, 0021, 0023, 0061, 0153).

What Aldis et al does not explicitly teach is

downgrading software associated with first license key including obtaining a second license key and disabling the first license key.

Stupek Jr. et al discloses a method comprising downgrading software associated with first license key including obtaining a second license key and disabling the first license key (col. 5, line 65-col. 6, line 45 "...maintaining old versions of upgraded resources allows the user to downgrade the resource if needed in the future....", see claim 29; ....downgrading ...resource from newer version back to old version....).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method of downgrading software associated with first license key including obtaining a second license key and disabling the first license key in view of the teachings of Stupek Jr. et al

in order to revert to old software version for reasons of compatibility or for any reason for that matter.

As per **claim 2, 13 and 24**, Aldis et al further discloses the method, wherein the software licenses available from the software license bank depend on a predetermined contract (0022).

As per **claim 5, 16 and 27**, Aldis et al further discloses the method, wherein the software license bank contains an unlimited number of licenses for some period of time (fig. 2 and 4, 0078).

As per **claim 7, 18 and 29**, Aldis et al further discloses the method, wherein the web application maintains digital records of software licenses, the digital records indicating rights associated with the software licenses (fig. 2, and 4, 0005, 0015, claim 79).

As per **claim 8, 19 and 30**, Aldis et al further discloses the method, wherein web application can be used to adjust the rights associated with the software license (0022, 0069, 0097).

As per **claim 9, 20 and 31**, Aldis et al further discloses the method, wherein the web application is used to provide license keys for the software (see figs. 2 and 19,

0077, 0087, claim 40).

As per **claim 10, 21 and 32,** Aldis et al further discloses the method, wherein the web application uses role based security (fig.1; 0021, 0022, 0023).

4. **Claims 3, 4, 6, 11, 14, 15, 17, 22, 25, 26, 28, and 33,** are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication 2004/0039916 in view of Stupek Jr. et al U.S. Patent No. 5,960,187 and further in view of Watanabe et al U.S. Patent Application Publication 2003/0182146 A1.

As per **claim 3, 14 and 25**, both Aldis et al and Stupek Jr. et al failed to explicitly disclose the method, wherein the software license bank stores predetermined dollar amount of licenses.

Watanabe et al discloses the method, wherein the software license bank stores predetermined dollar amount of licenses (figs. 3 and 4; 0038).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores predetermined dollar amount of licenses in view of the teachings of Watanabe et al in order to track number of available licenses.

As per **claim 4, 15 and 26**, Aldis et al and Stupek Jr. et al failed to explicitly disclose the method, wherein the software license bank stores a predetermined CPU count of software licenses.

Watanabe discloses the method, wherein the software license bank stores a predetermined CPU count of software licenses (fig. 3; ...number of license leases...).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores a predetermined CPU count of software licenses in view of the teachings of Watanabe in order to track license usages/limits.

As per **claim 6, 17 and 28**, Aldis et al and Stupek Jr. et al failed to explicitly disclose the method, wherein the software license bank stores a predetermined user count of software licenses.

Watanabe discloses the method, wherein the software license bank stores a predetermined user count of software licenses (fig. 3; 0027; ...number of customers...).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores a predetermined user count of software licenses in view of the teachings of Watanabe in order to track license usages.

As per **claim 11, 22, and 33**, both Aldis et al and Horstmann failed to explicitly disclose the method, wherein the web application stores configuration information for the computers running the licensed software.

Watanabe et al discloses the method, wherein the web application stores configuration information for the computers running the licensed software (0032).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the web application stores configuration information for the computers running the licensed software in view of the teachings of Watanabe et al in order ensure product and/or license compatibility.

5. **Claims 37,** is rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication 2004/0039916 in view of Watanabe et al U.S. Patent Application Publication 2003/0182146 A1.

As per **claim 37**, Aldis et al discloses a method comprising:

maintaining a software license bank for a customer, software licenses stored in the software license bank not being associated with specific machines (fig.1 and 11; 0013, 0014, 0018, claim 61); and

accessing a web application to allow a user to automatically obtain a software license for a specific machine from the software license bank, wherein the software

license is associated with a first license key (figs.1, 6 and 7; 0014, 0016, 0017, 0018, 0021, 0023, 0061, 0153).

Upgrading/downgrading software associated with first license key including obtaining a second license key and disabling the first license key (0099; 0100; 0105; 0119).

What Aldis et al does not explicitly teach is

wherein the software license bank stores a predetermined dollar amount of licenses.

Watanabe et al discloses wherein the software license bank stores a predetermined dollar amount of licenses (figs. 3 and 4; 0035; 0038; ...unit price of license key lease...made under contract...).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores predetermined dollar amount of licenses in view of the teachings of Watanabe et al in order to estimate the dollar amount of license keys acquired by the user.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art ad are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of

the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Charles C.L. Agwumezie** whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Andrew Fischer** can be reached on **(571) 272 – 6779**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charlie Lion Agwumezie
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Acc
October 16, 2007.

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